

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK A. KRULL

Appeal No. 2001-1402
Application 09/287,838

ON BRIEF

Before CALVERT, COHEN, and BAHR, Administrative Patent Judges.
CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 to 19, 21, 22 and 24 to 27. The other claims in the application, 20 and 23, have been withdrawn and indicated as allowable, respectively.

The claims on appeal, which are reproduced in the appendix of appellant's brief, are drawn to the combination of

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an accessory and a shoe.

The prior art applied in the final rejection is:

1969	Meier	3,473,198	Oct. 21,
1991	Williams	5,042,119	Aug. 27,
1993	Handzlik	5,246,749	Sep. 21,
1997	Gourley	5,671,517	Sep. 30,

(filed Sep. 9,
1996)

The appealed claims stand finally rejected on the following grounds:

- (1) Claims 1, 3, 5 to 7 and 25, anticipated by Meier, under 35 U.S.C. § 102(b);
- (2) Claims 14 and 15, anticipated by Gourley, under 35 U.S.C. § 102(e);
- (3) Claims 14 to 16 and 19, anticipated by Williams, under 35 U.S.C. § 102(b);
- (4) Claims 1 to 6, 8 to 10, 12, 13 and 17 to 19, unpatentable over Gourley in view of Meier, under 35 U.S.C. § 103(a);
- (5) Claims 1 to 3, 5 to 8, 11 to 13, 21, 22, 24, 26 and 27,

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unpatentable over Handzlik, under 35 U.S.C. § 103(a).

Rejection (1)

Claim 1 reads:

1. An accessory in combination with a shoe of the type having a toe portion, a heel portion, and a transversely extending closure disposed therebetween, comprising:

a figurine configured to stand erect on a floor surface; and

a means for releasably securing the figurine to the closure on the shoe.

Meier discloses a shoe having a toe, heel, and closure (laces) therebetween. Attached to the laces by holes 16 through which the laces extend is an enclosure 1 having hinged top and bottom portions 4, 3. A molded figure 2, shown as a clown's head in Fig. 1 but disclosed as possibly being a Disney animated character or other popular children's figure (col. 2, lines 56 to 61) is provided on top portion 4. The examiner takes the position that claim 1 is anticipated because Meier's figure 2 is a figurine which will stand erect on a floor surface when removed from the shoe. Appellant argues that Meier's clown's head 2 is not a figurine, since it does not include a representation of a body; that it is not

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configured to stand erect on a floor surface; and that Meier's "means for releasably securing" is not the same as, or equivalent to, the corresponding structure disclosed by appellant¹ (brief, pages 4 and 5).

It is well settled that "[t]o anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently." In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). Also, words in a claim are to be given their ordinary and accustomed meaning, unless clearly defined differently by the inventor, In re Paulsen, 30 F.3d 1475, 1480 31 USPQ2d 1671, 1674 (Fed. Cir. 1994), and limitations are not to be read into the claims from the specification. In re Van Geuns, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993). In the present case, appellant does not define "figurine" in the specification, so it will be given its ordinary and accustomed meaning which, according to the dictionary definition accepted by appellant (reply brief, page 2) is "a small molded or sculpted figure; a statuette." Appellant argues that Meier's

¹Citing In re Donaldson Co., 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994).

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clown's head is not a "figure" because it does not include a bodily shape or form, but we consider this to be too narrow a reading of the term. Prior art references may be indicative of what a claim term would mean to one of ordinary skill in the art, In re Cortright, 165 F.3d 1353, 1358, 49 USPQ2d 1464, 1467 (Fed. Cir. 1999), and here the Meier reference itself refers to the clown's head 2 as a "molded figure" (col. 2, line 21). We therefore conclude that the clown's head 2 of Meier, being a small molded figure, constitutes a "figurine" as recited in claim 1.

As for whether Meier's figurine is "configured to stand erect on a floor surface," as claim 1 requires, the top and bottom portions 3, 4 of the Meier accessory 1 would form a base or pedestal of the figurine when accessory 1 was removed from the shoe, thereby allowing the figurine to stand erect on the floor. Appellant's argument that hinge members 11 would prevent this (brief, page 3) is not understood, but in any event, the modification shown in Meier's Fig. 4 clearly would meet the claim requirement in question.

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We also consider the "means for releasably securing" recited in claim 1, construed in accordance with 35 U.S.C. § 112, sixth paragraph, to be met by Meier.

In the elected species of appellant's invention, Figs. 27 and 28, the structure which corresponds to this means is slots 479 in base member 470, which slots may be provided to accommodate shoelaces for attaching the device to a shoe (page 21, lines 21 to 26). Since Meier discloses the same structure, namely, holes 16 in bottom member 3 to receive shoelaces (col. 2, lines 42 to 47), it meets the claimed means.

Claim 5 recites:

5. The accessory of claim 1, wherein the means supports the figurine in an upright stance on the shoe.

Since Meier's clown's head 2 is "upright," i.e., is essentially vertical on the shoe as shown in Fig. 1, this claim's limitations are met.

Claim 6 recites:

6. The accessory of claim 1, wherein the means includes an elongate strip extending lengthwise beneath the closure on the shoe.

Appellant asserts that Meier's bottom portion 3 is not "an

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elongate strip" as claimed, because, as appellant defines "elongate" on page 6 of the specification, the length must be at least one and one-half times greater than the width. However, according to appellant's own measurements (brief, page 7), Meier's base member (bottom portion) is 1d (1.375) inches wide by 2¼ (2.25) inches long. Since this calculates as a length which is 1.636 times greater than the width, Meier's bottom portion 3 meets appellant's definition of "elongate." Also, bottom portion 3 extends lengthwise beneath the shoe closure in that it is under the portion 18 of the laces.

Claim 7 depends from claim 6, and recites that the figurine is releasably secured to the strip. This limitation is not readable on the Meier apparatus, since figurine 2 is shown as

being integrally molded with top portion 4 (see Fig. 4), and top portion 4 is permanently attached to bottom portion 3 by hinges 11.

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In view of the foregoing, rejection (1) will be sustained as to claims 1, 5 and 6, as well as to claims 3 and 25 which appellant has not argued separately from claim 1, but not sustained as to claim 7.

Rejection (2)

Claim 14 recites:

14. An accessory in combination with a shoe selected from the group consisting of a first type of shoe, having a lace-type closure, and a second type of shoe, having a hook-and-loop-type closure, comprising:

a base;

a first means, on the base, for selectively anchoring the base to the lace-type closure on the first type of shoe without interfering with operation of the lace-type closure;

a second means, on the base, for selectively anchoring the base to the hook-and-loop-type closure on the second type of shoe without interfering with operation of the hook-and-loop type closure; and

an amusing object connected to the base and visible from above in each said combination.

Gourley discloses a shoe in combination with a safety guard 1 for the shoe laces. The guard has inner and outer hinged members 2, 4 with interengaging hook and loop material 9 on their facing surfaces. A tab 5 on the inner member is snapped around a lace 7, and the ends of the laces are tied in

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a bow 10 which is held between the inner and outer members. Hook and loop material is provided on the outer surface 11 of the outer member 4 for attachment of "an emblem, safety device or other object," such as reflector 12 (col. 2, lines 35 to 40).

Appellant argues that the Gourley device does not anticipate claim 14 because it does not include a second means for selectively anchoring the base to a hook-and-loop type shoe closure "without interfering with operation of the hook-and-loop type closure," as claimed. The examiner states in the final rejection (page 3) that Gourley has "a second equivalent means (Velcro on the inner surface or tab/snap (5,6)), " and that the claim does not require a shoe with a hook and loop closure. However, while the latter statement is correct, claim 14 still requires the second means, and the examiner does not explain how the identified Velcro or tab/snap perform the recited function of that means.

Nevertheless, we consider that the Gourley device contains a second means, as recited. If the shoe 8 of Gourley were the conventional shoe 890 with a hook and loop type

closure as

described by appellant at page 30, lines 8 to 22 of the specification and shown in Figs. 49 and 50, the straps 895 would pass across inner member 2 of Gourley, through a loop or opening on opposite flap 894, and back, the overlapping portions of the straps interconnecting by means of the hook and loop fasteners thereon (page 30, lines 18 to 22). Thus the straps would be anchored to base 2 of Gourley's device in essentially the same manner as laces 7, in that outer member 4 would fold down over the interengaged straps. The second means would not interfere with operation of the hook and loop closure in that the straps and the openings through which they pass would still be accessible, just as the eyelets in the shoe for Gourley's laces 7 are. Thus, since Gourley discloses structure capable of performing the functional limitations of the second means, it meets that means. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

No other distinctions between claims 14 and 15 and

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Gourley being argued by appellant, rejection (2) will be sustained.

Rejection (3)

In making this rejection the examiner asserts that the pocket 70 disclosed by Williams (Fig. 5 and col. 7, lines 38 to 58) corresponds to the "amusing object" recited in claim 14. However, even assuming this to be correct, we will not sustain the rejection because we agree with appellant's argument (brief, page 11) that the pocket is not "visible from above in each said combination" as the claim requires. As indicated by the arrows 40, 42 in Williams Fig. 5, the pocket would not be visible from above when in use because member 20 is closed by folding it and the pocket 70 medially so that it is held in an "encapsulatory position" (similar to that shown in Fig. 4). See col. 7, lines 50 to 58.

Rejection (4)

With regard to independent claims 1 and 8, the basis of this rejection, as stated on page 5 of the final rejection, is:

[i]t would be an obvious [sic: have been obvious] for the object of the shoe as taught by Gourley to be an

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enclosure having the clown head (figurine), as taught by Meier, in order to store small object[s] and to be used as a toy when unattached to the shoe. Obviously the device would be attached by Velcro, as the object 12 of Gourley is attached.

Appellant argues that it would not have been obvious to attach the item 1 of Meier as the object 12 of Gourley, because the Meier item would present a hazard of snagging shoelaces, whereas Gourley's device is designed to reduce the possibility of snagging. The examiner points out at page 6 of the answer, however, that the shoelaces would not snag on the Gourley/Meier device because they would be disposed between elements 2 and 4. Thus, we agree with the examiner that one of ordinary skill would have found it obvious to modify the Gourley device in view of Meier, for the reason stated by the examiner, *supra*.

Appellant further argues that Meier's enclosure is not a figurine as claimed, but we disagree for the reasons discussed above in connection with rejection (1).

As for claims 2 and 4, we consider that Gourley discloses the means recited therein; see the discussion of rejection (2), *supra*.

For claim 6, appellant presents the same argument concerning Gourley as he did for Meier, namely that Gourley's strip (inner member) 2 is not "elongate" because it does not have a length at least one and one-half times greater than the width. This argument is not borne out by appellant's own measurements (brief, page 14), however, because a length of $1\frac{11}{16}$ (1.6875) inches is exactly $1\frac{1}{2}$ times the width of 1C (1.125) inches.

Appellant further argues as to claims 12 and 18 that the figurine of Meier, when attached to outer member 4 of Gourley, would not "extend[] perpendicular to the strip when mounted on the base" (claim 12), and would not "stand[] erect on top of the base" (claim 18). This argument is not persuasive. The clown's head 2 of Meier extends essentially perpendicular to portions 3, 4, of the enclosure, as shown in Fig. 1 of Meier, and stands erect relative to them. With the device 1 of Meier attached to the top of outer member 4 of Gourley, the clown's head would extend perpendicular to the elongate strip, i.e., Gourley's inner member 2, since members 2 and 4 are essentially parallel in use (see Gourley Fig. 5), and would

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stand erect on top of Gourley's outer member 4.

The remaining arguments concerning claims 12, 17 and 18 are repetitive of those addressed above.

In view of the foregoing, rejection (4) will be sustained.

Rejection (5)

Handzlik discloses an attachment for a shoe, including a base member 8 with a clip 18 for attachment to, *inter alia*, laces 17 (col. 3, lines 47 to 52). Removably attached to a post 7 on the base member is an antenna 3, to which may be secured "an amusement or ornamental device such as a ball 9, flower, pompon or the like" (col. 3, lines 12 to 15). Each of the rejected claims requires, *inter alia*, a figurine.

Although Handzlik does not disclose a figurine, the examiner's position is that (final rejection, page 6):

It would appear to be an obvious design choice for the object [of Handzlik] to be a figurine inasmuch as a number of different object[s] appear to be suitable in carrying out of the basic concept of the invention. This view is buttressed by applicant's disclosure which does not reveal that the use of the specific figurine solves any particular problem and/or yields any unexpected results. Moreover, it

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would have been obvious to construct the object/emblem with any appropriate change in appearance such as [a] figurine or any other desired aesthetic design, *In re Seid* [,61 F.2d 229,] 73 USPQ 431 [(CCPA 1947)].

We will not sustain this rejection. "A rejection based on section 103 clearly must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art." *In re GPAC, Inc.*, 57 F.3d 1573, 1582, 35 USPQ2d 1116, 1123 (Fed. Cir. 1995). In this rejection, the examiner has not cited any evidence as to why it would have been obvious to use a figurine as the amusement or ornamental device of Handzlik, so that the rejection would appear to be based on impermissible hindsight derived from appellant's own disclosure. The *In re Seid* case (decided prior to the 1952 Patent Act) does not aid the examiner, in that it concerns the patentability of the particular shape and arrangement of a figure, and not whether it would have been obvious to use a figure instead of a non-figure.

Conclusion

Rejection (1) is affirmed as to claims 1, 3, 5, 6 and 25,

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and reversed as to claim 7. Rejections (2) and (4) are affirmed. Rejections (3) and (5) are reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

IAN A. CALVERT)	
Administrative Patent Judge)	
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IRWIN CHARLES COHEN)	
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